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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,484	12/17/2003	RONALD E. GILLINGHAM	81094960 (202-1590)	1483

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EXAMINER

PIERCE, JEREMY R

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 02/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/707,484

Applicant(s)

GILLINGHAM ET AL.

Examiner

Jeremy R. Pierce

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 14-21 is/are pending in the application.
- 4a) Of the above claim(s) 1-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11, 12 and 14-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed on December 14, 2005 has been entered. The amendment is non-compliant with 37 CFR 1.121 because claims 1-10 have not been given their proper status identifier. Claim 1-10 should be marked with the "withdrawn" status identifier instead of the "original" status identifier. Additionally, the amendment is also non-compliant because the text of cancelled claim 13 is shown in the amendment. The text of cancelled claims should not appear according to 37 CFR 1.121. However, the amendment will be entered despite the non-compliance in order to expedite prosecution.
2. In the amendment, Applicant cancels claim 13. Therefore, claims 1-12 and 14-21 are currently pending with claims 1-10 withdrawn from consideration. The cancellation of claim 13 renders moot the 35 USC 112 and 102 rejections set forth in sections 7, 9, and 11 of the last Office Action against that claim.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 1771

4. Claims 12 and 14-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Carroll et al. (US 2002/0017805).

Carroll et al. disclose an energy absorbing assembly (Abstract). An upper layer having contours may be combined with a lower layer having contours so that a cavity is formed between the two layers (Figures 13 and 15). Carroll et al. also disclose that the material meets head injury criteria (paragraph 68). With regard to claim 16, Carroll et al. teach other components that may be included in the composite, including delta structures (paragraph 57), acoustic dampeners (paragraph 60), and pellets or beads (paragraph 65). With regard to claims 17-20, the recesses are circular in nature (Figure 11) and Carroll et al. teach other shapes may be used (paragraph 43). With regard to claim 21, Carroll et al. use a thermoplastic sheet (paragraph 51).

5. Claims 12 and 14-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Wandyez (U.S. Patent No. 6,086,145).

Wandyez discloses a headliner wherein cavities are formed between the upper substrate and a lower substrate (Abstract). Both upper and lower layers have a plurality of contours (Figure 1). With regard to claims 14 and 15, both upper and lower layers have convex and concave members (Figure 3). With regard to claim 16, foam or cables may be provided in the cavities (Abstract). With regard to claims 17-20, the shape of the cavities may be rectangular or square (column 4, lines 40-49 and Figure 3). With regard to claim 21, the substrate may be plastic (column 4, line 29).

Claim Rejections - 35 USC § 102/103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 11 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Carroll et al.

With regard to claim 11, the patentability of a product does not depend on its method of production. "If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, (Fed. Cir. 1985). Once the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983). In this case, Carroll et al. disclose all physical and structural limitations of the product claim.

8. Claim 11 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wandyez.

With regard to claim 11, the patentability of a product does not depend on its method of production. In this case, Wandyez disclose all physical and structural limitations of the product claim.

Response to Arguments

9. Applicant's arguments filed December 14, 2005 have been fully considered but they are not persuasive.

10. Applicant argues that Carroll et al. do not disclose a headliner, but rather Carroll et al. is devoted to a structure which could be buried within the core of a headliner. This argument is without merit. First, it is noted that Carroll et al. teach the composite material of their invention is used in a headliner (See claim 10 of Carroll et al.). Therefore, Carroll et al. disclose a headliner. Second, Applicant's recitation of a headliner is found in the preamble of the claims. This amounts to a recitation of an intended use of the composite material. If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999). Applicant points to features of a headliner which are described in the Specification at paragraph 3. However, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

11. Applicant argues that there is no upper layer and separate lower layer with Wandyez because Wandyez forms passages by blow molding. However, Wandyez clearly shows an upper layer and a separate lower layer (See Figures 3 and 4).

Applicant asserts the headliner of the present invention includes top and bottom layers that are independent prior to being joined together. However, the status of the layers prior to being joined together is immaterial because the claim requires that the top layer and bottom layers be "substantially joined together." Since the claim requires joining the top and bottom layers together, the status of those layers as not being joined together prior to their integration is irrelevant.

12. Applicant argues that Carroll et al. fail to teach a structure that is vacuum formed and has top and bottom layers joined together to form an integral headliner. However, the patentability of a product does not depend on its method of production. So long as the prior art meets the structural limitations of a product claim, it is valid prior art.

13. Applicant argues that Wandyez fails to teach upper and lower layers that are separate and then bonded together. However, the patentability of a product does not depend on its method of production. So long as the prior art meets the structural limitations of a product claim, it is valid prior art.

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

Art Unit: 1771

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

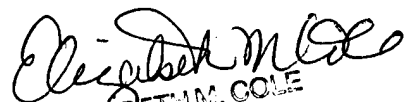
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy R. Pierce whose telephone number is (571) 272-1479. The examiner can normally be reached on normal business hours, but works flextime hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeremy R. Pierce
January 26, 2006


ELIZABETH M. COLE
PATENT EXAMINER